

REMARKS

Favorable reconsideration of the present patent application is respectfully requested in view of the foregoing amendments and the following remarks.

In this Amendment claims 41-48 are added, claims no are canceled and claims 2, 12, 19 and 24-25 are amended. As a result, claims 1-12, 19-29 and 34-48 are now pending in the application.

In the Office Action of April 20, 2007, claims 1-12, 19, 22-25, 28-29 and 34-38 are rejected under 35 U.S.C. §103(a) in view of U.S. Patent 5,737,029 (Ohkura) further in view of U.S. Patent 6,021,419 (Clarke) and yet further in view of U.S. Patent 5,734,589 (Kostreski). Claims 20-21 and 26-27 are rejected under 35 U.S.C. §103(a) in view of the Ohkura patent further in view of the Clarke patent, yet further in view of the Kostreski patent, and yet even further in view of U.S. Patent 6,002,394 (Schein).

§103 Rejections in view of Ohkura / Clarke / Kostreski / Schein

The §103 rejection of claims 1-12, 19, 22-25, 28-29 and 34-38 in view of hypothetical combination of Ohkura, Clarke and Kostreski, and the §103 rejection of claims 20-21 and 26-27 in view of hypothetical combination of Ohkura, Clarke, Kostreski and Schein are respectfully traversed.

The Ohkura patent involves a television controller that displays a channel guide with channels arranged in a usage-based order. This allows a viewer to choose a favorite program from among the many received broadcast channels. Ohkura describes the process of creating the

usage-based favorite channel guide list as follows.¹ Upon detecting that a channel is being received, the Ohkura system saves data concerning the channel number, time of reception for the television program and the category of the received broadcasting channel. Once a sufficient period of data has been collected (e.g., four weeks), the Ohkura system creates a usage-based favorite program guide list that reveals how often the user watches programs of various categories during different times of the day.

The Office Action relies upon the Ohkura patent for its description of a computerized system for managing favorite channels. The Office Action acknowledges that Ohkura does not disclose several of the claimed features, including means for selecting predefined keywords for the user specified theme, or means for identifying channels which relate to the user specified theme by detecting a match of the predefined keywords, etc. However, the Office Action then goes on to propose combining the Clarke patent with Ohkura to overcome these deficiencies of Ohkura. This hypothetical combination proposed by the Office is deficient for at least the following reasons.

The Office Action acknowledges that Ohkura does not disclose “means for selecting predefined keywords for the user specified theme,” or “means for identifying said one or more logical channels which relate to the user specified theme by detecting a match of the predefined keywords of said user specified theme,” or other features recited in the claims. However, the Office Action then contends that Clarke discloses these features missing from Ohkura. This contention is respectfully traversed. The Office Action points to Clarke’s use of source fields in a message, wherein the source fields contain source identifiers which may be matched up with

¹ Ohkura, col. 7, line 63 to col. 8, line 21, and steps S1 – S3 of Figure 11.

channel identifiers in a preference list. The incoming message is discarded if the source identifier of the incoming message does not match a channel identifier.²

The Clarke patent does not pertain to a system for managing favorite channels. The Clarke patent involves a system that filters broadcast type messages having a given protocol from a network to a computer. That is, Clarke filters broadcast digital information messages sent via a network in accordance with channel identifiers stored in a preference list by comparing the channel identifiers with fields of the message packets.

It is believed that the Office Action contends Clarke's use of source fields of the incoming message packets somehow relate to keywords. It should be noted, however, that the source fields of Clarke's incoming messages contain identifiers (e.g., numeric identifiers) which are not keywords. Hence, Clarke does not disclose or suggest "selecting predefined keywords," as recited in the independent claims.

Further, Clarke's numeric identifiers are used to *filter out* incoming messages, not to *identify logical channels* related to a user specified theme for storing in a favorite channels list. In fact, the Clarke patent expressly states that its patent pertains to a "novel filter process 800 [which] is a process which conditionally discards or accepts broadcast messages 500."³

Moreover, the system described in the Clarke patent would require considerable alteration to work in the manner of the claimed invention "within a predetermined number of timeslots" since the Clarke system sends an add-channel command at the beginning of the content broadcast and a delete channel command at the end of the content broadcast. This is explained in the following passage of Clarke:

² Clarke, col. 10, line 49 to col. 11, line 11.

For example, a source named soccer.spanish.com providing a particular soccer game **could first send an add-channel command** 415A loading the channel identifier 5 in field 605 and the station identifier soccer.spanish.com in the field 610. When a packet 195 containing the channel identifier 5 is received by the adapter 300, process 800 then replaces the channel identifier 5 with the actual source identifier, soccer.spanish.com. In this way, an adapter can use a limited number of preference records 625, e.g. 32, to access an infinite number of predesignated information sources. This designation can be performed by the broadcast source. Further, this can be **done in a dynamic manner through the use of the add and delete commands 415A, 415B**, respectively.⁴

Accordingly, the hypothetical Ohkura / Clarke combination do not teach or suggest “means for identifying said one or more logical channels which relate to the user specified theme by detecting a match of the predefined keywords of said user specified theme, said identifying being based on programming constrained within a predetermined number of timeslots ahead of a current time,” as recited in claim 1, or the similar features recited in the other claims. **In the event the pending rejection is maintained, it is respectfully requested that the next paper explain how the channel identifiers of Clarke can identify programming constrained within a predetermined number of timeslots ahead of a current time if the channel identifier are embedded within the content?**

A third cited patent to Kostreski is also included in the pending rejection of claims 1-12, 19, 22-25, 28-29 and 34-38. However, the Kostreski patent also fails to overcome the deficiencies of Ohkura and Clarke. Kostreski involves a digital entertainment terminal with channel mapping. The Kostreski system can control the formatting of different types of graphics displays overlaid on video programming for different services, can specify different definitions for input keypad functions, can specify security procedures, and can enable operation of

³ Clarke, col. 7, lines 39-40.

⁴ Clarke, col. 10, line 66 to col. 11, line 11.

associated peripheral devices such as credit card readers. However, the Kostreski system does not produce a theme-based favorites lists based on a user specified theme, or involve means for selecting predefined keywords for the user specified theme, or the other claim features discussed above. Hence, Kostreski does not overcome the deficiencies of Ohkura and Clarke.

A fourth cited patent to Schein is also included in the pending rejection of claims 20-21 and 26-27. The Schein patent involves systems and methods for linking television viewers with advertisers and broadcasters, and allows viewers to link and search information on the Internet. The Schein patent does not teach a theme-based favorites lists based on a user specified theme, or involve means for selecting predefined keywords for the user specified theme, or the other claim features discussed above. Hence, Schein does not overcome the deficiencies of Ohkura, Clarke and Kostreski.

Accordingly, it is respectfully submitted that Ohkura, Clarke, Kostreski and Schein, either taken singly or as hypothetical combinations, do not teach or suggest the features of the claimed invention. Therefore, withdrawal of these rejections is requested.

Ohkura Teaches away from the Combination

The §103 rejection of claims 1-12, 19, 22-25, 28-29 and 34-38 is respectfully traversed because the Ohkura patent teaches away from being combined with Clarke. This hypothetical Ohkura / Clarke combination proposed by the Office is respectfully submitted to be improper for at least two reasons.

Firstly, according to MPEP §2145 it is improper to combine references where the references teach away from their combination.⁵ The hypothetical combination of Ohkura and Clarke is submitted to be improper under §2145 because Ohkura teaches away from being combined with Clarke. The Ohkura patent has a well defined process in place for creating a usage-based favorite program guide, as outlined in conjunction with Figure 11 of the Ohkura patent. Since Ohkura has an established process in place already, there would be no need to create a different type of favorite program guide to conform to aspects of the Clarke patent simply for the sake of managing favorite channels in a different manner. Therefore, the Ohkura patent teaches away from being combined with Clarke.

Secondly, the hypothetical combination of Ohkura and Clarke proposed by the Office is not proper under MPEP §2143.01(V) which states that the proposed modification cannot render the prior art unsatisfactory for its intended purpose. Combining Clarke with Ohkura would be improper under §2143.01(V) because Ohkura provides a system for creating a usage-based program guide. In fact, Ohkura expressly states that its program guide list that reveals “how often the user has watched programs of what category in each time band.”⁶ Thus, it would be improper to change the manner in which the Ohkura system operates by moving away from its usage-based program guide. **In the event the pending rejection is maintained, it is respectfully requested that the next paper explain how altering the Ohkura system to perform in accordance with Clarke can still allow the Ohkura system to reveal how often the user has watched program of various categories in each time band, a stated objective of Ohkura.**

⁵ MPEP §2145 citing In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

The Office Action also proposes to combine third and fourth cited patents, the Kostreski and Schein patents, to Ohkura and Clarke to overcome yet more deficiencies. The third and fourth cited Kostreski and Schein patents do not heal the deficiencies of the §103 rejection caused by Ohkura teaching away from combination with Clarke.

Accordingly, the §103 rejection relying upon the hypothetical combination of Ohkura, Clarke, Kostreski and Schein is respectfully submitted to be improper. Therefore, withdrawal of these rejections is requested.

§103 Rejection of Claims 39-40

Further regarding the §103 rejection of claims 39, the Office Action contends that Clarke teaches the feature of claim 39. It is not clear what portion of the Clarke patent is being construed to teach or suggest this feature. Clarke merely shows a picture of a satellite in Figure 2, and mentions that “the server 121 can be part of a (satellite) communication ground station 120.”⁷ This passing reference to satellite systems does not appear to rise to the level of teaching the claimed feature. Therefore, it is respectfully submitted that neither Clarke, nor any other art of record, either teach or suggest “wherein said predefined keywords are direct broadcast satellite (DBS) content descriptors,” as recited in claim 39. These features are included in newly added claims 41, 43, 45 and 47.

Further regarding the §103 rejection of claims 39, the Office Action contends that Clarke teaches “wherein said one or more logical channels are identified to relate to the user specified theme by the match of the predefined keywords independent of a number of times the one or

⁶ Ohkura, col. 8, lines 8-11.

more logical channels have been viewed,” as recited in claim 40. However, the Clarke system does not pertain to the management of favorite channels. The Ohkura patent, on the other hand, involves the management of favorite channels through a usage-based favorites list, thus teaching away from the features recited in claim 40. Therefore, it is respectfully submitted that neither Ohkura, Clarke, nor any other cited art, either teach or suggest the features of claim 40. These features are included in newly added claims 42, 44, 46 and 48.

⁷ Clarke, col. 7, lines 4-5.

Deposit Account Authorization / Provisional Time Extension Petition

It is believed that the Fee Transmittal Sheet attends to all necessary claim fees and no extension of time is required for this filing. However, to the extent necessary, a provisional petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-0439 and please credit any excess fees to such deposit account.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. However, in the event there are any unresolved issues, the Examiner is kindly invited to contact applicant's representative, Scott Richardson, by telephone at (571) 748-4765 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,



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